

## REMARKS

1. **Rejection of claims 1-3, 5, 6 and 17 under 35 U.S.C. § 102(b) as anticipated by DeJovine, U.S. Patent No. 4,144,166, hereafter “DeJovine” or “166”.**

The rejection of claims 1-3, 5-6, and 17 as anticipated by DeJovine has been maintained.

Independent claim 1 has been amended to more clearly define the claimed invention. Support for this amendment may be found on page 8, lines 12-17.

DeJovine discloses the controlled release of solid particles contained in a polymer composition or in a suspension. It is an aspect of DeJovine that these particles be

“sized sufficiently small to substantially avoid being removed from the lubricating oil composition by filter means used to remove solid contaminants from the composition. Preferably, a major portion, by weight and more preferably, substantially all, of such solid particles, have a maximum traverse dimension in the range of about 1 millimicrons to about 2 millimicrons, and most preferably in the range of about 1 millimicron to about 500 millimicrons.”

*See ‘166, col. 4, lines 42-50*

In contrast, Applicants’ amended independent claim 1 now requires that the particles retained in the chemically active filter member have a diameter in a range of 0.1 to 6 millimeters. *See Applicants’ Specification, page 8, lines 12-14.* Applicants’ range when converted to microns is from 100 microns to 6,000 microns.

The Undersigned notes the PTO’s reliance upon DeJovine’s disclosures at col. 2, lines 57-60 for the proposition that DeJovine “...clearly teaches (see col. 2, lines 57-60) that the size of the particles employed is not critical and may vary over a wide range.” *See Office Action of 6/16/04, page 3.*

However, it is respectfully submitted that this portion of DeJovine refers to the size and weight of the ‘...solid particles-containing *means*’ rather than the size of the individual particles. As noted above, DeJovine clearly teaches that the particles must be of sufficiently small size so as not to be removed by the filter means.

Accordingly, it is respectfully noted that DeJovine fails to disclose a required element of Applicants' amended independent claim 1. Indeed, use of Applicants' particle size would result in a nonworking embodiment in DeJovine.

Accordingly, it is respectfully submitted that the invention of amended independent claim 1 is novel over the disclosures of DeJovine. In as much as dependent claims 2-3, 5-6, and 17 incorporate the limitations of amended claim 1, they are likewise believed to be novel over DeJovine.

New claim 18 is novel over DeJovine because DeJovine fails to disclose a chemically active filter member comprised of a plurality of particles that are retained in the oil filter wherein the particles comprise from 90 to 97% by weight of a beneficial additive that is at least one of an antioxidant, an anti-wear agent, a basic salt, or a mixture thereof, based on based on the total solid weight of the particles.

Entry of the amendments and new claim 18 is respectfully requested as well as favorable action.

**2. Rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over DeJovine, U.S. Patent No. 4,144,166, hereafter "DeJovine" or "166" in view of Bilski, U.S. Patent No. 5,725,031, hereafter "Bilski" or "031".**

The rejection of claim 4 has been maintained. Reconsideration of claim 4 is respectfully requested in view of the foregoing amendment to claim 1.

Bilski is relied upon by the PTO for the disclosure of an oil filter having a mechanically active filter member and a chemically active filter member disposed within the mechanically active filter element.

Applicants must respectfully disagree. Bilski does not rectify the above noted deficiencies of DeJovine. That is, Bilski does not teach the use of the particularly required particles of Applicants' claimed invention.

Accordingly, reconsideration of the rejection is respectfully requested.

**3. Rejection of claims 7-10 and 13-16 under 35 U.S.C. § 103(a) as being unpatentable over DeJovine, U.S. Patent No. 4,144,166, hereafter "DeJovine" or "166" in view of Brownawell, U.S. Patent No. 5,225,081, hereafter "Brownawell" or "081".**

Brownawell is relied upon by the PTO for the disclosure of an oil filter having both a mechanically active filter member and a chemically active filter member, and the illustration of a filter housing and supplemental cartridge having the recited construction.

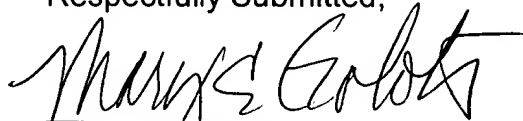
Applicants must respectfully disagree. Brownawell does not rectify the above noted deficiencies of DeJovine. That is, Brownawell does not teach the use of the particularly required particles of Applicants' claimed invention.

Accordingly, reconsideration of the rejection is respectfully requested.

### **CONCLUSION**

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

  
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